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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUDIGER KURTZ
and ALFRED BUBIK

Appeal 2008-3768
Application 10/619,424
Technology Center 1700

Oral Hearing Held: October 22, 2008

Before EDWARD C. KIMLIN, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

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1 The above-entitled matter came on for hearing on Wednesday,
2 October 22, 2008, commencing at 1:06 p.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Dawn A.
4 Brown, Notary Public.

5 THE USHER: Calendar Number 23, Mr. Miller.

6 JUDGE KIMLIN: Good afternoon, Mr. Miller.

7 MR. MILLER: Good afternoon.

8 JUDGE KIMLIN: Dawn is our reporter today. She will get
9 every word you say down precisely. You can begin when you're ready. You
10 have about 20 minutes.

11 MR. MILLER: Okay. I guess I'll just start. I'm John Miller for
12 the appellant, Rudiger Kurtz. The present invention is an apparatus for
13 paper making, and specifically the calender roll and the application of a
14 coating to the paper.

15 When you make paper, it is usually made of cellulose fiber,
16 which is highly hydrophilic. Basically, it can easily be wetted and swollen.
17 So part of this process and the apparatus is directed to this liquid
18 impregnating agent that is coated on the paper.

19 It is called a size, and what the invention here is trying to solve
20 is that with thinner paper grades, the size is applied to the surface and that is
21 sufficient. But when you're dealing with thicker paper grades, the problem
22 is, how do you get that size into the center of the paper through the thickness
23 because it doesn't penetrate as deeply?

24 So what the present invention does is it utilizes an elastic
25 compression in the calender rolls. And what this does is it basically
26 squeezes the paper, but the paper will then expand as it passes through the

1 coating device. And what that does is it acts to suck in this coating agent
2 and it will then be drawn into the center of the paper.

3 In rejecting the claims, the examiner applies one reference in a
4 103 obviousness rejection, and the examiner contends that it would be
5 obvious to -- it would be obvious that the reference teaches that it would be
6 capable of providing for an elastic compression.

7 Our arguments -- there are two arguments. The first is that this
8 reference expressly teaches away from this type of modification. The
9 reference teaches that the purpose of the calendering is to improve the paper
10 quality by pressing the paper into a particular standard for final thickness. It
11 also sets forth that the calender roll provides for a fixed final density.

12 Notwithstanding this, the examiner asserts that it would be
13 obvious that the 585 reference would be capable of providing this elastic
14 compression.

15 But our argument is that there is an express teaching in the
16 reference that teaches away from this, and it is completely contrary.

17 The reference teaches that the purpose of the calendering is to
18 find a final thickness and a fixed final density, whereas with the present
19 invention, we are not putting in -- we are putting it through the calender roll,
20 and the calender roll provides for an elastic compression, meaning that you
21 are not getting the final thickness out of there.

22 You are going to get a thickness that is going to expand down
23 the later stages of the apparatus.

24 So that being said, that is our position that the examiner has to
25 consider the reference as a whole, and the reference explicitly says that the
26 purpose of the calendering is to put it into a final thickness of fixed final

1 density.

2 If you were to modify it to provide for an elastic compression,
3 our contention is that it would be unsatisfactory for its intended purpose.
4 And it expressly states the purpose is to provide a final thickness.

5 JUDGE GAUDETTE: Where does that say that with respect to
6 the -- what their invention is in the reference?

7 MR. MILLER: In the reference, it is -- it is -- it is in the third
8 and fourth paragraphs of the reference. If you look in the third paragraph --

9 JUDGE GAUDETTE: Isn't that talking just a background
10 discussion?

11 MR. MILLER: That is a background discussion. The
12 invention -- yeah, it is the background discussion. There is no other
13 discussion of it in the reference.

14 JUDGE GAUDETTE: But isn't that true of the prior art in
15 general, though, that that is what calendering generally does? I mean, that is
16 a true statement of what the prior art is. That is not necessarily what the
17 reference is doing.

18 MR. MILLER: Well, I believe that the reference, it is talking
19 about the prior art, but it is also talking about this invention. This invention
20 doesn't change things with respect to what it is stating in this paragraph here.
21 It doesn't do anything differently than what is stated here. So it is our
22 position that this is teaching the purpose of the calendering is to provide a
23 final thickness.

24 That being said, the second argument goes to the fact that the
25 examiner does not set forth any -- hasn't articulated any reasoning as to why
26 someone might modify the reference to provide for this elastic compression.

1 The examiner basically is making conclusory statements it would be obvious
2 that it would be capable of doing so, but the examiner doesn't say why.

3 Now, assuming the argument that it would be capable of
4 providing for an elastic compression, the burden is still on the examiner to
5 say, Why? To say, This would be done for some advantage, some reason,
6 and the record is silent as to that. And so it is our position the examiner
7 really hasn't set forth a prima facie case of obviousness leaving out a critical
8 element.

9 And further, you know, that being said that the examiner hasn't
10 set forth any motivation, it appears that the motivation is coming from the
11 art disclosure itself. It seems to be impermissible hindsight reasoning that is
12 occurring here. And so for those two reasons, you know, it is our position
13 that the 103 is, per se, invalid.

14 And the third point I wanted to address was the examiner's
15 answer, because in our appeal brief we set forth these two arguments, and
16 the second one being, hey, there is no -- you only have conclusory
17 statements here.

18 There is no articulated reasoning with some rational
19 underpinning to support your conclusion of obviousness. You're just merely
20 asserting it without saying anything. And the examiner's answer didn't
21 address this argument at all.

22 The answer must include any necessary rebuttal of arguments
23 presented in appellant's brief, a statement of whether the examiner disagrees
24 with each of the arguments or contentions of the appellant with respect to the
25 issues presented, and an explanation as to the reasons for the disagreement.
26 And that was not set forth in the examiner's answer.

1 This is a bit of a side issue because it is kind of dealing with
2 later down the process of the examiner's answer. But it goes back to my
3 second issue, which is that we don't have any statement as to why someone
4 would do such a thing in light of the reference -- well, not in light of the
5 reference, but why someone would do that, which is necessary regardless of
6 the teaching.

7 JUDGE KIMLIN: Mr. Miller, I noticed that the claims don't
8 specify any particular range or distance for the distance between the coating
9 device and the calender.

10 MR. MILLER: Sure.

11 JUDGE KIMLIN: How different is that distance over
12 conventional devices in the art?

13 MR. MILLER: Well, I don't have an answer for you with
14 regard to that. It would be dependent on a number of factors with regard to
15 the amount of compression that you are applying and, obviously, the paper --
16 the contents of the paper before it is paper.

17 That would affect the amount of how long it would stay in a
18 compressed state before it started to rebound and bounce back to its -- a
19 thicker shape. But I couldn't say specifically what that distance is and how
20 that is.

21 JUDGE GAUDETTE: Is there a discussion in the specification
22 as to how one would determine that distance?

23 MR. MILLER: I don't believe that there is with regard -- well, I
24 mean, it seems that the distance could be -- it is determined that one of
25 ordinary skill in the art would understand what is involved here in setting
26 these distances between the calender roll and the coating apparatus.

1 JUDGE KIMLIN: Is -- it seems like the thrust of your
2 invention is selecting the distance between the calender and the coating
3 device.

4 MR. MILLER: I believe that it is that combined with the width
5 at the nip. The nip is where your calender roll is squeezing the paper, and if
6 you vary that thickness or the distance that it is squeezed along with the
7 pressure --

8 JUDGE KIMLIN: But you claim a wide nip calender.

9 MR. MILLER: That is correct.

10 JUDGE KIMLIN: Which is, I guess, a term of art.

11 MR. MILLER: That is correct.

12 JUDGE KIMLIN: And this is -- these type calenders are
13 known?

14 MR. MILLER: That is right.

15 JUDGE KIMLIN: So there is no real distinction over that
16 aspect?

17 MR. MILLER: There -- I mean, I think that there is. The
18 reference that is being applied discloses a calender nip width of 50 -- greater
19 than 50 and then embodiments greater than 70 millimeters.

20 JUDGE KIMLIN: And your distinction over that is?

21 MR. MILLER: What is that?

22 JUDGE KIMLIN: And your distinction over that is?

23 MR. MILLER: Our device operates with a -- can operate with
24 a much larger nip width, up to 700 millimeters.

25 JUDGE KIMLIN: It can, but it does not necessarily have to.

26 MR. MILLER: That is right. Those are the factors that would

1 affect the extent of the compression and would affect, then, the distances
2 between the two different elements of the paper-making device, the calender
3 and the coating apparatus.

4 JUDGE KIMLIN: It seems like you're claiming an idea rather
5 than an actual process or apparatus.

6 MR. MILLER: Well, I mean, the apparatus is structured to
7 provide this elastic compression. I would argue that it is --

8 JUDGE KIMLIN: Its enablement has never been an issue here?

9 MR. MILLER: I'm sorry?

10 JUDGE KIMLIN: Enablement has never been an issue here?

11 MR. MILLER: It has never been brought up in the record, no.
12 And I think that there are structural features. Like I said, the width of the
13 nip, the resiliency of the jacket. How it works is there is a calender roll
14 where there is a roll on top and what is called a shoe on the bottom. And
15 over that shoe runs this jacket, which is elastic.

16 And I think that those two features along with how we space --
17 with regard to at least claim 1, how we space the coating apparatus from the
18 calendering roll or the structure that we have discussed and that distinguish
19 and that provide for this elastic compression.

20 I mean, I think that the primary -- the two primary issues are
21 that the reference expressly teaches away from the modification. I don't
22 think you can ignore that.

23 I think when the reference says, This is the purpose of the roll,
24 the calender roll, that you can't then just say, Well, notwithstanding that, it
25 would be obvious to provide for this less compression because that is
26 contrary to the intended purpose of the calendering roll as disclosed in the

1 reference.

2 JUDGE GAUDETTE: I guess the way I read it was just that
3 they were seeking to plasticize the surface fibers, which is exactly the same
4 thing that is stated.

5 MR. MILLER: That is a good question. There is basically two
6 things going on here. There is the plasticization of the surface layer, and
7 that occurs not through the compression, not through the pressure, but
8 through the heat that is applied. Both inventions do that. Both inventions
9 have this plasticization aspect.

10 But what we're talking about with the present invention is the
11 degree of the elastic compression that is provided for, not the plasticization
12 of the surface. The reference -- that is what I was saying before. The
13 reference does state here at the beginning that we have -- the purpose is the
14 final thickness and that is it.

15 It doesn't say there may be any advantages to doing anything
16 else with regard to this thickness. All it says is the calender roll -- the
17 purpose of the calender roll is a fixed final thickness, meaning that it doesn't
18 change after that point. That is the thickness of the paper.

19 JUDGE HASTINGS: Well, isn't the examiner's position, you
20 alluded to it, that the apparatus of the reference is capable of being operated
21 at various pressures? And from what you're telling us, it is highly
22 dependent, what thickness you get of the paper ultimately, on the thickness
23 you apply to these calender rolls. And I don't know that that is adequately
24 reflected in your device claims.

25 MR. MILLER: It is not that -- the pressure is certainly going to
26 affect the thickness. Obviously, the more you press, you're going to reduce

1 the thickness of the paper. What this invention does, is it is applying a
2 pressure over a greater surface area using lighter pressures so that you're not
3 applying a permanent change to the thickness of the paper.

4 With regard to the capability, I don't think you can say -- I don't
5 think you can just look at that in a vacuum. You have to look at this
6 reference in totality.

7 And the fact that the reference states the purposes of final
8 thickness -- the purpose of the calendering is to provide a final thickness
9 with a fixed final density, I think that -- with that there -- well, assuming
10 argument that it would be capable, which we don't concede, you can't ignore
11 it in light of what the reference is teaching.

12 The reference is saying this and it is completely contrary to
13 what our invention is doing, and so I think that that is the issue. I mean, the
14 reference is expressly -- explicitly, rather, teaching away from what the
15 examiner is saying it would be capable of doing. It is contrary to the
16 intended purpose of the calendering roll in the prior art.

17 And with that being the case, I don't think the examiner is free
18 to make a 103 obviousness rejection saying, Well, it would be capable of
19 doing it regardless of the fact that it is contrary to its intended purpose. I
20 think that is what the case law says with regard to intended purpose. You
21 can't ignore that statement.

22 So are there any other questions that you guys have?

23 JUDGE KIMLIN: I think we're through with the questions.

24 MR. MILLER: Okay. Well, thank you very much for your
25 time and --

26 JUDGE KIMLIN: Thank you for coming.

- 1 MR. MILLER: It is my pleasure.
- 2 JUDGE KIMLIN: Have a good afternoon.
- 3 MR. MILLER: You do the same.
- 4 Whereupon, the proceedings at 1:22 p.m. were concluded.